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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/741,156	12/21/2000	Jari Maenpaa	367.39359x00	5543

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EXAMINER
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BAYAT, BRADLEY B

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/741,156

Applicant(s)

MAENPAA ET AL.

Examiner

Bradley Bayat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 13-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-34 is/are rejected.
- 7) ☒ Claim(s) 16, 23, 29-34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

Applicant has cancelled claimed 1-12 and added new claims 13-34 in the amendment file on 22 March 2004. Thus, new claims 13-34 are presented for examination on the merits.

Applicant's amendments to the specification, abstract and drawings have been entered.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Objections***

**Claims 16, 23, and 29-34 are objected to because of the following informalities:**

- Claim 16 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 14 which claim 16 depends on refers to a "spent token" and claim 16 further defines a "PreToken."
- As per claim 23, the result defining a Redeemed Token appears to be mistyped indicating a minus sign instead of an equal sign.
- Independent claims 29-34 improperly refer back to other independent claim. An independent claim cannot further limit another independent claim.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 29-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 29-43 fail to particularly point out what the applicant regards as the invention in each claim by omitting essential elements, steps or a structural relationship between such elements or steps, amounting to a gap between the elements/steps. See MPEP § 2172.01. By merely referring back to an independent claim, the applicant cannot satisfy the requirement under Section 112.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 13-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee, U.S. Patent 6,748,367 B1.**

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As per the following claim, Lee discloses:

13. (New) An electronic commerce system comprising:

- a customer (column 5, lines 47-55),
- an issuer of at least one token (column 8, lines 8-10),
- a vendor which sells goods or services (column 8, lines 13-18) and
- a delegate which can spend the at least one token with the vendor (column 8, lines 52)

and wherein:

- the customer receives at least one token from the issuer, the at least one token being stored in a portable radio communication device of the customer (column 8, lines 18-21),

- the customer activates the at least one token for use in buying the goods or the services from the vendor (column 11, lines 3-22),

- the customer selects between spending the at least one token with the vendor to buy the goods or services (column 13, lines 53-60), or

- delegates the at least one token to the delegate via a radio communication device of the delegate such that the delegate can spend the at least one token with the vendor to buy the goods or services (column 16, lines 19-21).

14. (New) A system according to claim 13 wherein: the vendor presents a spent token to the issuer who redeems the token for monetary value (column 9, line 65-column 10, line 2; column 11, lines 57-61).

15. (New) A system according to claim 13 wherein: the at least one token comprises a PreToken given by,  $\text{PreToken} = S(\text{Rp}, \text{Auth}, \text{Ss})$  wherein S indicates an executable event in which Rp represents the Recipient, Ss represents the Sender and Auth is indicative of the goods/service (column 8, lines 13-55).

16. (New) A system according to claim 14 wherein: the at least one token comprises a PreToken given by,  $\text{PreToken} = S(\text{Rp}, \text{Auth}, \text{Ss})$  wherein S indicates an executable event in which Rp represents the Recipient, Ss represents the Sender and Auth is indicative of the goods/service (column 8, lines 13-55).

17. (New) A system according to claim 15 wherein: the PreToken is grouped to provide a GroupToken given by,  $\text{GroupToken} = \text{sequence of (PreToken)}$  (column 8, lines 21--25; column 12, lines 59-67; figure 11 and associated text).

18. (New) A system according to claim 16 wherein: the PreToken is grouped to provide a GroupToken given by,  $\text{GroupToken} = \text{sequence of (PreToken)}$  (column 8, lines 21--25; column 12, lines 59-67; figure 11 and associated text).

19. (New) A system according to claim 17 wherein: the PreToken or GroupToken is assigned to provide a DelegatedToken given by,  $\text{DelegatedToken} = S(\text{PreToken/GroupToken}, \text{Dp}, \text{Cs})$ , wherein S indicates an executable even in which a PreToken or GroupToken is

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transferred from the Customer (Cs) to the Delegate (Dp) (column 12, lines 44-67; column 16, lines 4-5, 20-21).

20. (New) A system according to claim 18 wherein: the PreToken or GroupToken is assigned to provide a DelegatedToken given by,  $\text{DelegatedToken} = S(\text{PreToken}/\text{GroupToken}, \text{Dp}, \text{Cs})$ , wherein S indicates an executable event in which a PreToken or GroupToken is transferred from the Customer (Cs) to the Delegate (Dp) (column 12, lines 44-67; column 16, lines 4-5, 20-21).

21. (New) A system according to claim 19 wherein: the PreToken, GroupToken or Delegated Token is spent with the vendor to provide a SpentToken or a SpentDelegatedToken given by,  $\text{SpentToken} = S(\text{PreToken}/\text{GroupToken}, \text{Mp}, \text{Cs})$ , wherein S indicates an executable event in which a PreToken or GroupToken is spent by the customer (Cs) with the vendor (Mp), and  $\text{SpentDelegatedToken} = S(\text{DelegatedToken}, \text{Mp}, \text{Ds})$ , wherein S indicates an executable event in which a DelegatedToken is spent by the delegate (Ds) with the vendor (Mp) (column 12, lines 10-67).

22. (New) A system according to claim 20 wherein: the PreToken, GroupToken or Delegated Token is spent with the vendor to provide a SpentToken or a SpentDelegatedToken given by,  $\text{SpentToken} = S(\text{PreToken}/\text{GroupToken}, \text{Mp}, \text{Cs})$ , wherein S indicates an executable event in which a PreToken or GroupToken is spent by the customer (Cs) with the vendor (Mp), and  $\text{SpentDelegatedToken} = S(\text{DelegatedToken}, \text{Mp}, \text{Ds})$ , wherein S indicates an executable

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event in with a DelegatedToken is spent by the delegate (Ds) with the vendor (Mp) (column 12, lines 10-67).

23. (New) A system according to claim 21 wherein: the vendor redeems the SpentToken or SpentDelegatedToken with the issuer to result in a RedeemedToken given by, RedeemedToken – S(SpentToken/SpentDelegatedToken, Ms), wherein S indicates an executable event in which a SpentToken or SpentDelegatedToken is redeemed by the vendor (Ms)(column 9, line 65-column 10, line 2; column 11, lines 57-61)..

24. (New) A method for providing electronic commerce involving a customer, an issuer, a delegate and a vendor comprising: the customer receives at least one electronic token from the issuer and stores the token in a portable radio communication device of the customer, the customer activates the at least one electronic token so that the at least one electronic token is usable for obtaining goods or services from the vendor, and the customer selects between spending the token with the vendor, or delegating the token to the delegate by transferring the token to a portable radio communication device of the delegate for storage therein (see claim 1 citations).

Claims 25-28 are directed to a system, portable device and method of operating the above claimed invention, and as such, all the claim limitations have been addressed by the above rejected claims and corresponding citations.



Although improper and indefinite, claims 29-34 all recite the limitation “at least one parameter specifying use of the token...” [See column 8, lines 25-42.]

*Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.*

#### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

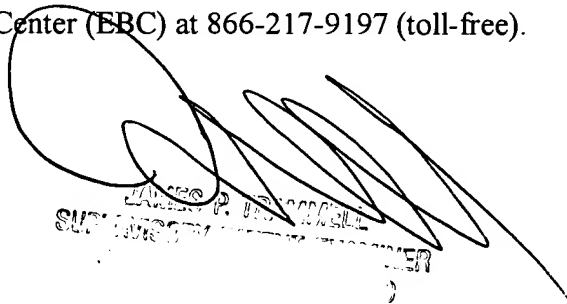
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Bayat whose telephone number is 703-305-8548. The examiner can normally be reached on Tuesday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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